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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,000	09/30/2003	Hans-Rudolf Nageli	ATM-2358	2806

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EXAMINER	
PARKER, FREDERICK JOHN	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/674,000	NAGELI ET AL.	
	Examiner	Art Unit	
	Frederick J. Parker	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *10-16 and 24-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 17-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1-2-04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9,17-23, drawn to Coating Method, classified in class 427, subclass 457.

II. Claims 10-16,24-29, drawn to Apparatus, classified in class 118, subclass 604.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used for another and materially different process such as applying localized or continuous coatings to non-flexible substrates, the coatings being other than sealants, e.g. paint, reactants, fibers, etc. It is also noted the method alone requires EMB.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Virgil Marsh on 10/30/05 a provisional election was made with traverse to prosecute the invention of group I, Method claims 1-9,17-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-16,24-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

6. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Europe on 10/7/02 & 11/25/02. It is noted, however, that applicant has not filed a certified copy of the EU applications as required by 35 U.S.C. 119(b).

Specification

7. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(f) BACKGROUND OF THE INVENTION.
(1) Field of the Invention.
(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
(g) BRIEF SUMMARY OF THE INVENTION.
(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(i) DETAILED DESCRIPTION OF THE INVENTION.
(j) CLAIM OR CLAIMS (commencing on a separate sheet).
(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

8. The disclosure is objected to because of the following informalities: on page 3, lines 27-28, the last 2 lines are redundant, "...basis of a printers copy i.e. printers copy". What does this mean? Appropriate correction is required.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Objections

10. Applicant is advised that should claims 3,4,6-9 be found allowable, claims 18-23 will be objected to under 37 CFR 1.75 as being a **substantial duplicate thereof**. When two claims in an application are duplicates or else are so close in content that they both cover the same thing,

despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

11. Claims 8,22 are objected to because of the following informalities: claims 8,22 read the monitoring thickness of the layer not yet deposited ("to be deposited"); it is suggested "deposited" be inserted before "sealing layer" and the current "to be deposited" be deleted for clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 17 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 17 provides for the use of "film type laminate", but, since the claim does not set forth any steps involved in the **method/process**, it is unclear what method/process applicant is

intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

15. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 2 is vague and indefinite because the meaning of "a two-component deposition system" is unclear since it is unclear what two components (i.e. 2 formulations, 2 applicators, etc) form a system for deposition.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1-5,18,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Handels US 6342273.

The method applies paint/ varnish particles to metal, paper, textile, or plastic substrates (including cardboard for packaging, col. 12, 52-53) wherein all or a part of the substrate is powder coated (col. 11,51-52). The method is a powder transfer method comprising charging coating particles and mixing them with magnetic carrier particles, followed by contacting the mixture with a substrate, wherein an electric field transfers the powder to the substrate, after which the coated substrate is melted and fused by radiation or an oven (col. 11, 23- col. 12, 24).

Transport means includes a magnetic brush apparatus and use of magnetic carrier particles, therefore a two component deposition system. Use of photocopying technology (synonymous with electrophotographic) to move substrates and charge/ apply powder is cited on col. 2, 54-62. Materials applied include polyesters, methacrylates, varnishes (same art meaning as lacquer), etc. Since Applicants specification page 2, 16-20 defines the "sealing layer" to be " in form of dry particles i.e. powder particles, and preferably in the form of a powder paint", which can be electrostatically charged, the reference meets Applicants' limitation of depositing a sealing layer.

Claim Rejections - 35 USC § 103

18. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handels. Handels is cited for the same reasons previously discussed, which are incorporated herein. Specific coating and process details are not cited.

However, as previously discussed, varnishes/ lacquers are encompassed by the powder paints of Handels, and therefore the use of such powders to form a hot-sealing layer would have been obvious because the processes of the reference is cited for similar non-uniform powder paint coatings. Photocopying technology necessarily includes electronic data processing per claim 7.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the process of Handels using hot-sealing materials because Applicants define such materials in terms of powder paints, and coating technology using data processing to provide reproducibility of the non-uniform powder coatings.

20. Claims 8,9,22,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handels in view of Liu US 6376148.

Handels is cited for the same reasons previously discussed, which are incorporated herein. Regulating thickness is not cited.

Liu teaches a powder coating layer application process, encompassing electrophotographic deposition, in which the thickness of applied layers are monitored by electronic sensors (col. 20, 66-col. 21, 9; etc) . Since Handels teaches the requirements for specific thicknesses on col. 2, 35-38, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Handels by incorporating the concept of sensor means as taught of Liu to monitor and assure the desired thickness of the applied powder coatings.

Per claim 9, the process cited is a continuous coating process to provide an economically feasible process for applying reproducible powder coatings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp